

REMARKS

Applicant respectfully submits that the present invention is distinguishable over each of the prior art references cited by the Examiner, and in support presents the following arguments.

In commenting upon the references and in order to facilitate a better understanding of the differences that are expressed in the claims, certain details of distinction between the references and the present invention have been mentioned, even though such differences do not appear in all of the claims. It is not intended by mentioning any such unclaimed distinctions to create any implied limitations in the claims. Not all of the distinctions between the prior art and Applicant's present invention have been made by Applicant. For the foregoing reasons, and without prejudice, Applicant reserves the right to submit additional evidence showing the distinctions between Applicant's invention to be non-obvious in view of the prior art.

The remarks herein are intended to assist the Examiner in re-examining the application and in the course of explanation may employ shortened or more specific or variant descriptions of some of the claim language. Such descriptions are not intended to limit the scope of the claims; the actual claim language should be considered in each case. Furthermore, the remarks are not to be considered to be exhaustive of the facets of the invention that render it patentable, being only examples of certain advantageous features and differences that Applicant's attorney chooses to mention at this time.

Response to 35 U.S.C. § 102 Rejection**Klein fails to disclose a transesterified fatty acid ester**

Applicant respectfully submits that independent claim 2 contains elements not found in Klein et al (US 5,468,405) ("Klein"). Claims 4, 16 and 19-23 depend from claim 2 and therefore incorporate the same limitations as the independent claim 2 and are patentably distinct.

Claim 2 requires a composition including reaction products from a reaction of a ricinoleic acid with a compound containing a hydroxyl functional group in the presence of a phosphorus-containing acid, the reaction products including a transesterified fatty acid ester and a phosphorus-containing compound. As the Examiner noted, Klein teaches a reaction of two compounds, namely, castor oil and an acidic catalyst such as phosphoric acid. Klein then discusses mixing, not reacting, the resulting Klein product with any of a laundry list of components. Klein's resulting product is not a transesterified fatty acid ester but a mixture of the dehydrated castor oil taught in Klein, which is not transesterified, with any number of other components. Klein does not discuss a transesterified fatty acid ester anywhere in the disclosure. Therefore, Klein is missing one of the required elements of claim 2.

It is required that the Examiner's prepare a showing that every element of the invention exists in the cited prior art. Klein solely describes a process of dehydration of castor oil under conditions optimized to prevent polymerization. Applicant notes that no transesterification with exogenous alcohols is possible because alcohols are never added for reaction. The Declaration of Dr. Eric Simanek is enclosed in support of this determination.

The Examiner has not presented a showing that the transesterified fatty acid is inherent in Klein. Should the Examiner feel that the disclosure implies transesterification through some portion of the disclosure, Applicant requests that the Examiner identify the portions of Klein relied upon and any other resource relied upon from the Examiner to conclude that transesterification is disclosed. The Examiner must provide rationale or evidence tending to show inherency. MPEP 2112. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established

by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" MPEP 2112 citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). If the Examiner is relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) Applicant respectfully submits that Klein is missing at least the transesterified fatty acid ester required in claim 2. Klein merely identifies that the dehydrated product resulting from the invention might be mixed with any number of known lubricants. This physical mixture of alcohol and dehydrated castor oil is completely different from the transesterified fatty acid ester resulting from and required by claim 2. Therefore, the transesterified fatty acid ester is missing, both discretely and inherently, from Klein.

Other difference

While it is sufficient to show that Klein does not teach a transesterified fatty acid ester, other differences also exist between the instant claims and Klein and are discussed in previous office actions. Applicant respectfully submits that all limitations of the claim must be considered. A composition of matter is "a composition of two or more substances [or] . . . a[] composite article, whether [it] be the result[] of chemical union, or of mechanical mixture . . ." MPEP 2106, (quoting *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957)). It is permissible to claim compositions in terms of a function, property or characteristic. "The structure implied by the process steps should be considered when assessing patentability . . . over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart

distinctive structural characteristics to the final product." MPEP 2113. See, e.g., *In re Garner*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding "interbonded by interfusion" to limit structure of the claimed composite and noting that terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched" are capable of construction as structural limitations.) In this case, Applicant believes the Examiner's exclusion of distinct limitations in the claim that define the composition are improper as those limitations distinctly and uniquely identify the composition at issue as required. The proper test for this type of claim should be whether it "distinctly claims" the invention. "All that is necessary is that the patentee make a full disclosure and that he describe the product with sufficient particularity that it can be identified and that those who are interested in its manufacture are enabled to determine what will and what will not infringe." *In Berger Labs, Ltd. V. R.K. Laros Co.*, 135 U.S.P.Q. (BNA) 11 (3d Cir. 1963). Therefore, the current claim limitations requiring the reaction of three specific components in the presence of each other is a manner of uniquely describing and limiting the resulting transesterified fatty acid and phosphated compound and therefore must be considered for purposes of patentability. Therefore, all of the differences discussed in the previous response are elements that are missing from Klein.

In view of the Examiner's statements regarding process steps, Applicant submits **claim 144** as a method claim involving the same process steps with the same resulting composition that has already been searched. No new matter has been introduced.

In summary, Klein teaches a dehydrated molecule derived from the starting castor oil whereas Applicant teaches a new chemical entity by virtue of a transesterification process. Klein is missing the transesterified fatty acid of claim 2 and those claims that depend therefrom. Claims 4, 16, 19-23 are patentable for the reasons above. Claim 144 is also patentable for this reason.

Response to 35 U.S.C. § 103 Rejection

Applicant respectfully submits that claims 5, 9, 11-13, 24, 25, 32-38, 40, 44 and 46-48 are distinguishable from Klein combined with the knowledge of one of ordinary skill in the art.

Applicant respectfully submits, however, that the Examiner has failed to meet the first element of a *prima facie* case for obviousness. First, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the Klein reference or to combine teachings. The Examiner has the burden of showing, as such, and has not met it here.

There is nothing explicit in Klein that would suggest modification, there is also nothing implicit suggesting combining the reference with other unrelated chemical processes (i.e. transesterification). The Klein teachings, knowledge of one of ordinary skill in the art, and nature of the problem to be solved, as a whole, would not suggest doing so to those of ordinary skill in the art, as is required in MPEP 2143.01 and *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Other than to try to piece together the Applicant's invention, the Examiner does not state why one with ordinary skill in the art would be willing to combine the Klein reference to provide the missing elements of the current invention, in particular, the transesterified fatty acid ester. Even if the reference somehow could be combined or modified with the knowledge of one of ordinary skill in the art to produce the composition of the current invention, this still is not sufficient to establish a *prima facie* obviousness unless the prior art also suggests the desirability of the combination (i.e., the use of transesterified fatty acid ester instead of a dehydrated fatty acid). MPEP 2143.01. Not only is there no suggestion as to the desirability of the combination, discussed above, but also the combination would not in fact be desirable, as the teachings of Klein relate to reducing the KOH which teaches away from transesterification, as will be discussed *infra*.

No Reasonable Expectation of Success

The Examiner has also failed to meet the second element of a *prima facie* case for obviousness because there must be, and there is not in this present case, a reasonable expectation of success.

As noted above, Klein is missing at least transesterified fatty acid. The Examiner has pointed to no reference that suggests the transesterified fatty acid be added to Klein. There is no teaching in Klein that would allow the creation of a transesterified fatty acid ester. "[T]he presence or absence of a suitably operative, obvious process for making a composition of matter may have an ultimate bearing on whether that composition is obvious or nonobvious under 35 U.S.C. 103." *In re Maloney*, 411 F.2d 1321, 1323, 162 USPQ 98, 100 (CCPA 1969). "[I]f the prior art of record fails to disclose or render obvious a method for making a claimed compound, at the time the invention was made, it may not be legally concluded that the compound itself is in the possession of the public. MPEP 2144.09. As Klein fails to disclose or make obvious a method for making any transesterified fatty acid ester and, as noted above, as one of ordinary art would not determine that a transesterified fatty acid could be created under Klein, the claims of the current invention are rendered non-obvious. In fact, Klein teaches away from a transesterified fatty acid with its high KOH value as the Klein patent teaches the reduction of KOH values. Therefore, these claims are believed patentable over Klein in view of the level of ordinary skill in the art.

While Klein gives brief reference to mixing an alcohol with the product resulting from the initial reaction, there is no indication that a reaction takes place. As described above and as supported by the Declaration of Eric Simanek, Applicant believes that no reaction would take place upon mixing an alkanol with the dehydrated castor oil of Klein. The specification of Klein clearly

teaches mixing and not reacting as the various components listed for mixing act as carriers, not reactants.


The transesterified fatty acid of the invention shows surprising results, when compared to castor oil. Enclosed is the declaration of Fred Massey indicating results of testing showing the Falex failure load for several embodiments of the current invention and that of castor oil. As can be seen, the transesterified fatty acid ester of the invention is remarkably superior to castor oil with failure loads being triple that of castor oil.

In commenting upon the references and in order to facilitate a better understanding of the differences that are expressed in the claims, certain details of distinction between the references and the present invention have been mentioned, even though such differences do not appear in all of the claims. It is not intended by mentioning any such unclaimed distinctions to create any implied limitations in the claims. Not all of the distinctions between the prior art and Applicant's present invention have been made by Applicant. For the foregoing reasons, Applicant reserves the right to submit additional evidence showing the distinctions between Applicant's invention to be unobvious in view of the prior art.

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Reconsideration of the application and allowance of all of the claims are respectfully requested. In view of the foregoing Response, Applicant respectfully submits that all of the claims are allowable, and Applicant respectfully requests the issuance of a Notice of Allowance. Should further discussion regarding the application be desired by the Examiner, a telephone conference is respectfully requested. I can be reached at (713) 221-3306.

Respectfully submitted,


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